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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,461	11/05/2001	Rick Castanho	109140-0005U	3343
7590	07/13/2006		EXAMINER	
MIELE LAW GROUP 137 SOUTH MAIN STREET NATICK, MA 01760			DIVECHA, KAMAL B	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/007,461	CASTANHO ET AL.	
	Examiner KAMAL B. DIVECHA	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 May 2006.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-5, 13-17, 20-22 and 26-38 is/are pending in the application.

4a) Of the above claim(s) 27-38 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5, 13-17, 20-22, 26 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

**Response to Arguments**

Claims 1-5, 13-17, 20-22, 26-38 are pending in this application, of which claims 27-38 has been withdrawn from consideration due to following reasons:

**Election/Restrictions**

- I. Claims 1-5, 13-17, 20-22, and 26, were drawn to a process of messaging in response to an event, classified in class 709, subclass 204.
- II. Claims 27-38 are drawn to a graphical user interface (GUI), classified in class 715, subclass 700.

Newly submitted claims 27-38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as providing a graphical user interface for various functions. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), i.e. search required for group I is different than search required for group II, hence it creates serious administrative burden on the examiner, as such restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Therefore, only claims 1-5, 13-17, 20-22, and 26 are being considered.

Applicant's arguments filed May 25, 2006 have been fully considered but they are not persuasive.

In response filed, applicant argues in substance that:

- a. Gerace's system does not concern the definition of happenings of external events (remarks, page 10).

In response to argument [a], examiner disagrees in light of the following:

First, applicant expressly fails to provide a reasonable interpretation of the phrase "external", i.e. external in view of what? Therefore the phrase "external events" in the claims would simply be interpreted as events.

Secondly, the applicant fails to claim the subject matter distinctly. For example: the recited limitations "in response to the occurrence of a happenings", "defining happenings of external events", "messages" are too broad.

Applicant should also consider amending the claims to include phrases such as notifications, alerts, etc. instead of using the phrase such as "messages". The invention is distinctly directed to a notification system.

Also note that, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Gerace does teach and disclose the subject matter as set forth in claims 1 and 14.

Gerace at column 5 line 8 to line 14, expressly states that "...using the user profiling member to record the user's activities and this build a psychographic/behavioral profile of the user..." That is recording the user's activities and building behavioral profile for user is interpreted as defining happenings of the events.

At column 6, Gerace explicitly teaches defining happenings of external events in a categories that are in interest to user such as weather, trading, news, theater etc., and the user is provided with a specific messages regarding each of these categories (col. 6 L13-67).

Therefore based on the broadest reasonable interpretation, Gerace does teach the process as claimed in claim 1 and 14.

b. Applicant requested the examiner to provide evidence of prior art substantiating the statements made, concerning the Official Notice.

In response to applicant request and based on MPEP 2144.03 (c), examiner hereby provides an adequate evidence to support the findings of the official notice or the well-known subject matter.

Bilder (U. S. Patent No. 6,359,557 B2), from the same field of endeavor explicitly discloses the process of determining if the message is not received, and in response thereto, re-sending the message, and re-sending the message via different means and to different devices (see figure 7 step #s3006-s3016).

Levac et al. (U. S. Patent No. 5,872,926), from the same field of endeavor, expressly discloses the process of detecting if the message is not received (col. 7 L30-63), and sending the messages to different devices (see abstract, summary).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Gerace in view of either one of the references above, in order to detect a failure in a message delivery and resend the message to a different device.

One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in the previous rejection (non-final rejection, page 8).

**Detailed Action**

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1,3,4,13,14,16,17,22,26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,848,396 issued to Gerace.

As per claim 1, 14, Gerace teaches a method for service specific notification (Abstract) comprising the steps of:

- defining at least one service(Abstract, Figs.3B-5D, col.2, lines 1-67),
- defining happenings related to each service(Abstract, Figs.3B-5D, col.2, lines 1-67),
- listing recipients, recipients defined as users or other parties designated to receive messages(Abstract, Figs.3B-5D, col.2, lines 1-67),

- associating the recipients with each services(Abstract, Figs.3B-5D, col.2, lines 1-67),  
- defining and associating contact information with each of the recipients(Abstract,  
Figs.3B-5D, col.2, lines 1-67),

- composing specific messages for one or more of the recipients in response to one or more of the happenings occurring(Abstract, Figs.3B-5D, col.2, lines 1-67), and  
- in response to the occurrence of a happening, sending out the associated specific

messages to the associated recipients via the contact information(Abstract, Fig.3B, col.2, lines 1-67).

As per claim 3,16, wherein the step of defining and associating contact information includes the steps of associating a message delivery means, device, and scheduled times with the recipients(Figs.3B-5D, claim 24).

As per claim 4,17, further comprising the step of recording of messages delivered, happenings, times, means for delivery and device for delivery of the messages to the recipient (Figs.3B-3D, col.2, lines 1-67).

As per claim 22, further comprising: a database with a single central record of each user's contact information, wherein the contact information is related to messages and to the happenings (Figs.2B-5D, col.2, lines 1-67).

As per claim 13, 26 further comprising the steps of writing an application program resident in a customer's computer system, wherein the application program generates a triggering message to the service (col.2, lines 1-67), entering the occurrence of a happening into the customer's computer system, in response, the customer's computing system triggers the service by sending the triggering message with information enabling the service to send out the corresponding specific messages to the listed recipients and users(col.2, lines 1-67, col.6, lines 24-58).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,848,396 issued to Gerace in view of US Patent 6,829,334 issued to Zirngibl et al.(Zirngibl).

Gerace teaches all the limitations of claims 1 and 14, however does not teach as per claim 2,15, further comprising the steps of: subscribing and un-subscribing a user to one or more services, wherein the unsubscribed user is prohibited from being associated with those services.

Zirngibl teaches further comprising the steps of: subscribing and un-subscribing a user to one or more services, wherein the unsubscribed user is prohibited from being associated with those services(claims 1,2).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify the teachings of Gerace to subscribe and un-subscribe users to some service as taught by Zirngibl in order to have to option to sign up for service or cancel a service.

One ordinary skill in the art would have been motivated to combine the teachings of Gerace and Zirngibl in order to provide a system to let a user sign up or cancel a service.

3. Claims 20,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,848,396 issued to Gerace in view of US Patent 6,067,568 issued to Li et al.(Li).

Gerace teaches all the limitations of claims 1 and 14, however does not teach as per claim 20, further comprising the step of defining a set of privileges, authorizing users one or more of these privileges, and authorizing an administrator to exercise the privileges of the user and the privileges to create and edit messages, to change the privileges afforded to a user, to manage members of a service, and to track delivery of messages to recipients.

Li teaches defining a set of privileges(Figs.5-10), authorizing users one or more of these privileges(Figs.5-10), and authorizing an administrator to exercise the privileges of the user and the privileges to create and edit messages(Figs.5-10), to change the privileges afforded to a user(Figs.5-10), to manage members of a service(Figs.5-10), and to track delivery of messages to recipients(Figs.5-10).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Gerace to defining a set of privileges, authorizing users one or more of these privileges, and authorizing an administrator to exercise the privileges of the user and the privileges to create and edit messages, to change the privileges afforded to a user, to manage members of a service, and to track delivery of messages to recipients as taught by Li in order for system administrator to configure services for a user.

One ordinary skill in the art would have been motivated to combine the teachings of Gerace and Li in order to provide a system where a person that is part of a service has more authorization than a user.

As per claim 21, wherein the set of privileges includes logging in, creating a member, deleting a member, enabling/disabling members, editing a member, creating an event, tracking deliveries, and assigning privileges to members (Li, Figs.5-10). Motivation to combine set forth in claim 7.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,848,396 issued to Gerace in view of Office Notice.

Gerace teaches all the limitations of claims 1, and 14, however does not explicitly teach as per claim 5, further comprising the step of determining if the message is not received, and, in response thereto, re-sending the message and re-sending the message via different means and to different devices.

Office Notice is taken; it is obvious to one ordinary skill in the art to resend messages when a message is not received and resending it to the different device in order someone to receive urgent messages when one device is off or not able to receive messages.

One ordinary skill in the art would have been motivated to combine Gerace and resend messages when a message is not received and resending the message to a different device in order to provide a system where a user will receive important messages when one of the client's device is not able to receive certain messages or if the client's device is turned off.

**Additional References**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Bilder, U. S. Patent No. 6,359,557 B2.
- b. Levac et al., U. S. Patent No. 5,872,926.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

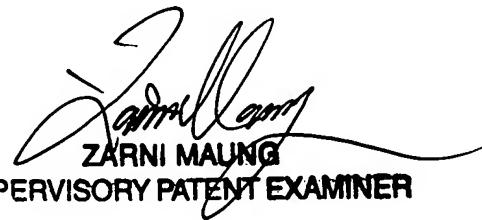
Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kamal Divecha  
Art Unit 2151  
June 28, 2006.



ZARNI MAUNG  
PERVISORY PATENT EXAMINER